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SALIWANCHIK LLOYD & SALIWANCHIK  
A PROFESSIONAL ASSOCIATION  
PO BOX 142950  
GAINESVILLE FL 32614-2950

In re Application of	:	DECISION ON
Highgate et al	:	
Application No.: 10/568,241	:	
PCT No.: PCT/GB2004/003570	:	
Int. Filing Date: 19 August 2004	:	PETITION UNDER
Priority Date: 22 August 2003	:	
Attorney's Docket No.: GJE-7555	:	
For: PHTOVOLTAIC CELL	:	37 CFR 1.147(a)

This decision is in response to applicant's "PETITION TO FILE APPLICATION WITHOUT SIGNATURE OF JOINT INVENTOR" submitted on 08 March 2007 that seeks the acceptance of the application without the signature of the joint inventor Lindsey Harrison. The Petition fee of \$200.00 has been charged to applicant's deposit account No.: 19-0065.

**BACKGROUND**

On 19 August 2004, applicants filed international application PCT/GB2004/003570, which claimed priority of an earlier application filed 22 August 2003.

On 14 February 2006, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the requisite basic national fee as required by 35 U.S.C. 371(c)(1). However, no executed declaration or oath was submitted at such time.

On 05 February 2007, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 indicating, *inter alia*, that "the oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the international application number and international filing date in that it is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68." The notification set two (2) months from the date of this notice or 32 months from the priority date for the application, whichever is later. Failure to properly respond will result in abandonment."

In an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4), applicants, *inter alia*, filed on 08 March 2007, a petition under 37 CFR 1.47(a), a declaration for U.S. Patent Application executed by Donald James HIGHGATE, and Simon BOURNE their behalf and on behalf on the nonsigning inventor HARRISON, and a declaration of David R. Saliwanchik.

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Furthermore, section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

#### **INVENTOR CANNOT BE REACHED:**

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under **37 CFR 1.47**, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under **37 CFR 1.47**.

Furthermore, the fact that an inventor is hospitalized and/or is not conscious is not an acceptable reason for filing under **37 CFR 1.47**. **37 CFR 1.43** may be available under these circumstances. See **MPEP § 409.02**. Such a petition under **37 CFR 1.47** will be dismissed as inappropriate.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

Petitioner has satisfied requirements (1), (3) and (4) of 37 CFR 1.47(a). However, requirement (2) has not been satisfied.

The averments of Mr. Saliwanchik are insufficient to support a finding that the nonsigning inventor, Ms. Harrison could not be found after diligent effort. The petition states that in an effort to locate Ms. Harrison, an ITM employee placed several calls to her personal mobile phone to no avail. However, this is insufficient to satisfy requirement 2.

Consequently, Mr. Saliwanchik fails to show diligent effort to locate inventor Ms. Harrison because no proof to corroborate his actions that Ms. Harrison could not be reached after diligent effort has been provided. For example, he has not shown that he has searched for the above non-signing inventor's new address by using a broad search in the internet or by using a phone director to try to locate Ms. Harrison's new address.

Moreover, it is not clear from the petition that it was Mr. Saliwanchik who performed the items listed in the petition, and has first hand knowledge of those facts as required by MPEP Section 409.03(d). If Mr. Saliwanchik was not the person who performed the actions listed in petition, petitioner will need to submit statements, with specific facts on the actions referred to in the petition by persons who have first-hand knowledge of such facts.

Accordingly, at this time it can not be concluded that the nonsigning Ms. Harrison could not be reached after diligent effort as stipulated under 37 CFR 1.47(a).

### **CONCLUSION**

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Rafael Bacares

PCT Legal Examiner

PCT Legal Office

Telephone: (571) 272-3276

Facsimile: (571) 273-0459